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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER

ALVAREZ, RAQUEL

ART UNIT	PAPER NUMBER
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3622

DATE MAILED: 06/14/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/414,121

Applicant(s)

STEEL ET AL.

Examiner

Raquel Alvarez

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 January 2002.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-9, 11-17, 19 and 21-27 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-9, 11-17, 19 and 21-27 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

- 15) ☐ Notice of References Cited (PTO-892)
- 16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 17) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 17.
- 18) ☐ Interview Summary (PTO-413) Paper No(s) _____.
- 19) ☐ Notice of Informal Patent Application (PTO-152)
- 20) ☐ Other: _____.

DETAILED ACTION

1. Claims 1-9, 11-17, 19 and 21-27 are pending.
2. The information disclosure statement filed 2/5/02 fails to comply with 37 CFR 1.98(a)(2), which requires a legible copy of each U.S. and foreign patent; each publication or that portion which caused it to be listed; and all other information or that portion which caused it to be listed. It has been placed in the application file, but the information referred to therein has not been considered.

Claim Rejections - 35 U.S.C. § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. **Claims 1- 9 11-17, 19 and 21-27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Altschul et al. (5,983,094 hereinafter Altschul et al.) in view of Goldhaber et al.(5,855,008 hereinafter Goldhaber) further in view of Titmuss et al.(WO 98/47295 hereinafter Titmuss).**

In regard to claims 1 and 12 Altschul teaches providing services in a wireless communication network(Abstract).

Providing a plurality of service to an end user of a wireless communication device operating on said wireless communication network (i.e. the wireless telephone (10) is constructed to enabled the customer to subscribe to a variety of services);

providing products or services to said end user in response to a subscription to one of the services(i.e. the end user accepts some of the services provided by the sponsor by entering a payment method)(col. 4, lines 59-, col. 5, lines 1-34).

Altschul does not specifically teach providing advertisements to the end user in lieu of receiving compensation for a subscription. Goldhaber teaches that the customers receive direct payment for receiving advertisements, which can be used to pay for goods and services(col. 12, lines 5-14). It would have been obvious to a person of ordinary skill in the art at the time of Applicant's invention to have included the teachings of Goldhaber of providing advertisements to the end user in lieu of paying for the subscription because such a modification would allow the advertisers to perhaps influence the customers minds in buying a particular product or service by means of the advertisements(col. 6, lines 20-27).

The combination of Altschul and Goldhaber do not specifically teach that the advertisements are based on the content received by the wireless communication device. Nevertheless, Titmuss teaches that the content (broadcast) that the user can receive or receives on said wireless device depends on the local area that user is in and based on the local area that the end user is in determines the shortlist of information sources to be transmitted to the end user(pages 17 and 18). It would have been obvious to a person of ordinary skill in the art at the time of Applicant's invention to have included advertisements based on the content of the received information from the user's device because such a modification would allow the system to filter out

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information and dynamically alter, thereby providing for personalized information distribution which alters the information delivered dynamically in accordance with the location of the user (in Titmuss page 5).

Claim 9 further recite providing advertisement based upon advertisement acceptance. It is obvious in the marketing and advertisement fields to provide further discounts or incentives to customers that are more likely to use coupons because such a modification would increase the chances that the coupons or incentives would be used.

Claims 13, 23 and 24 differ from claim 1 in that the advertisements are based on a configuration of the wireless device. Titmuss teaches that content that the user can or receives on said wireless device, e.g. graphics, voice etc. determines the type of advertisement(e.g. voice or image) that would be provided to the user of said device (page 20). It would have been obvious to a person of ordinary skill in the art at the time of Applicant's invention to have included advertisements based on the configuration of the device because such a modification would allow the system to only send advertisements that correspond to the device's capabilities.

With respect to claim 2, Altschul teaches that the user of the wireless communication network can subscribe to any of the plurality of service options. Altschul does not specifically teach that the service options include location based services. On the other hand, Titmuss teaches that the services options available are based on the location of the end user(page 17). It would have been obvious to a person of ordinary skill in the art at the time of Applicant's invention to have included location

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based services because such a modification would enable the system to determine a local facility that can satisfy the customer's needs.

With respect to claim 3, Titmuss teaches that the location related information includes position (page 9, last paragraph). It would have been obvious to a person of ordinary skill in the art at the time of Applicant's invention to have included position in the location related information because such a modification would enable the system to better service the customer based on their position.

With respect to claim 4, Titmuss teaches that the step of providing advertisements comprises providing an advertisement for a predetermined vendor when a subscriber is within a predetermined distance of said predetermined vendor(i.e. when a user is within a predetermined specified location of certain vendors; a service list providing information source descriptions associated with the location of the user)(page 17) . It would have been obvious to a person of ordinary skill in the art at the time of Applicant's invention to have included providing an advertisement for a predetermined vendor when a subscriber is within a predetermined distance of the predetermined vendor because such a modification would allow the customer to be aware of the vendors that are close by.

With respect to claim 5, Titmuss further teaches providing advertisements when end user preference corresponds with vendor criteria(i.e. based on the customer's identifying criteria and what the service provider offers(vendor) an individualized package and special tailored to meet the individual needs are presented to the customer)(page 24). It would have been obvious to a person of ordinary skill in the art

at the time of Applicant's invention to have included advertisements when end user preferences corresponds with vendor criteria because such a modification would allow the system to better target the advertisements.

With respect to claim 6, Goldhaber teaches requiring user interaction to determine whether an advertisement was reviewed to be considered an advertisement that was provided in lieu of receiving compensation for the service (i.e. the user has to provide a response to the ad to enable the advertiser to be assure that the customer reviewed the ad)(col. 5, lines 61-, col. 6, lines 1-7). It would have been obvious to a person of ordinary skill in the art at the time of Applicant's invention to have included requiring user interaction to determine whether an advertisement was reviewed to be considered an advertisement that was provided in lieu of receiving compensation for the service because such a modification would assure the advertiser that the customer is entitled to the compensation.

With respect to claims 7, 8, 15 and 16, Hall teaches that the advertisements are based upon a shopping list of said end user and shopping history of the end user (i.e. based on the customer's prior purchasing behavior and the list of things that the customer might purchase, a list of local facility and what they offer is provided to the end user (pages 14 and 19). It would have been obvious to a person of ordinary skill in the art at the time of Applicant's invention to have included advertisements that are based upon a shopping list of said end user and shopping history of the end user because such a modification would allow the system to better target the advertisements.

Claims 11 and 19 recite providing advertisements at predetermined times based

upon user device habits. Since, the combination of Altschul and Titmuss teach that the personal agent accesses customer database(i.e. user's preference data, including age, gender, interests, dynamic update preference, etc.) and retrieves information about customer's preferences to enable the system to provide advertisements based on the customer's preferences (in Titmuss, page 19) then it would have been obvious to a person of ordinary skill in the art at the time of Applicant's invention to have included in the user's preference data a predetermined time which would be convenient to the user to receive advertisements based on the user's habits because such a modification would provide the advertisements at a time that would be convenient to the user.

Claim 14 is similar in scope as claim 6 and therefore is rejected under similar Rationale.

Claim 17 is similar in scope as claim 9 and therefore is rejected under similar rationale.

With respect to claims 21, 22, 25 and 26 , Titmuss further teaches that the provision of the advertisement is based upon the determined location of said wireless communication device to a provider of at least one of said products or services (page 17). It would have been obvious to a person of ordinary skill in the art at the time of Applicant's invention to have included advertisements based upon the location of said wireless communication device because such a modification would provide a more focused advertisement and convenient advertisement to the user.

With respect to claim 27, the limitations were previously addressed above in the rejection to claims 12 and 13 and therefore is rejected under similar rationale.

Response to Arguments

4. Applicant's arguments filed 1/29/02 have been fully considered but they are not persuasive.

The 112 rejection was overcome by the amendment.

Applicant is reminded that Altschul was cited for “ **providing service in a wireless communication network; providing a plurality of service options to an end user of a wireless communication device operating on said wireless communication network; providing products or services to said end user in response to a subscription of one of said service options**”. Applicant argues that Altschul does not teach providing advertisements to the end user in lieu of receiving compensation for the subscription. Applicant is reminded that one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). In Altschul since, the end user can use telephone(10) to make purchases or subscribe to services displayed on the display screen then some sort of advertisements must exist in order to arouse a desire for the customer to buy or patronize a product. Goldhaber teaches that the customers are paid for their attention, the customers can use these funds to pay for products or services therefore the advertisements are provided instead of the customers having to pay for the products or services. Applicant is reminded that the Titmuss reference wasn't cited for providing advertisement to the customer in lieu of receiving compensation for a subscription but was instead cited for receiving information based

on the content being viewed. For the above reasons, the examiner asserts that the combination of Altschul et al., Goldhaber and Titmuss renders the claims obvious.

With respect to claim 12, Titmuss further teaches on page 5, that the location of the user is taken into account in order to enable information related to the user's location to be provided. The sensors in a vehicle determining the status would have been obvious for the same reasons as determining the user's location in the Titmuss's reference.

With respect to the obvious statement used in the rejection to claims 9 and 17, the Applicant is reminded that a 102 was not applied against the claims. As such, the Examiner respectfully submits that the issue at hand is not whether the applied prior art specifically teaches "providing advertisements based upon advertisements acceptance" recited in claims 9 and 17, *per se*, but rather, whether or not the prior art, when taken in combination with the knowledge of average skill in the art, would put the artisan in possession of this feature. Regarding this issue, it is well established that references are evaluated by what they suggest to one versed in the art, rather than by their specific disclosures, *In re Bozek*, 163 USPQ 545 (CCPA 1969). The issue of obviousness is not determined by what the references expressly state but by what they would reasonably suggest to one of ordinary skill in the art, as supported by decisions in *In re DeLisle* 406 Fed 1326, 160 USPQ 806; *In re Kell, Terry and Davies* 208 USPQ 871; and *In re Fine*, 837 F.2d 1071, 1074, 5 USPQ 2d 1596, 1598 (Fed. Cir. 1988) (citing *In re Lalu*, 747 F.2d 703, 705, 223 USPQ 1257, 1258 (Fed. Cir. 1988)). Further, it was determined in *In re Lamberti et al*, 192 USPQ 278 (CCPA) that:

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(i) obviousness does not require absolute predictability;
(ii) non-preferred embodiments of prior art must also be considered; and
(iii) the question is not express teaching of references, but what they would suggest.

According to *In re Jacoby*, 135 USPQ 317 (CCPA 1962), the skilled artisan is presumed to know something more about the art than only what is disclosed in the applied references. In *re Bode*, 193 USPQ 12 (CCPA 1977), every reference relies to some extent on knowledge of persons skilled in the art to complement that which is disclosed therein.

With respect to claims 7 and 15, the Examiner referred to the Hall reference in error when actually, it was meant to point out to pages 14 and 19 of the Titmuss' reference.

With respect to claims 11 and 19, since Titmuss teaches a personal agent accesses the customer's preferences in order to provide the advertisements best suited for the customers. The customers preferences can be the brand of a product, their interests, such as the time of the year that a product is purchased or the time of the day that a product is preferred therefore it would have been obvious to a person of ordinary skill in the art to have modified the combination of Atlschul and Goldhaber of providing advertisements with the teaching of Titmuss of taken into account the user's preferences such as a predetermined time because such a modification would help in customizing the ads to the user's convenience and preferences.

Conclusion

5. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Points Of Contact


6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Raquel Alvarez whose telephone number is (703)305-0456. The examiner can normally be reached on 9:00-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric w Stamber can be reached on (703)305-8469. The fax phone numbers for the organization where this application or proceeding is assigned are (703)872-9326 for regular communications and (703)872-9327 for After Final communications.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703)308-1113.

R.A.
6/7/02


MELANIE A. KEMPER
PRIMARY EXAMINER